

REMARKS

Reconsideration of the above-identified application as amended respectfully is solicited on behalf of the Applicants.

With the instant response, five (5) claims have been amended, and two (2) claims have been cancelled.

The claims now pending stand rejected as follows:

- Claims 1, 3-8, 10, 11, 23 and 24 under 35 U.S.C. § 102(b) as being anticipated by Hanrahan (U.S. Patent No. 5,767,060).
- Claims 1-8, 10, 12, 13 and 23 under 35 U.S.C. § 102(e) as being anticipated by Manzone (U.S. Patent No. 6,712,976).
- Claims 16-21, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Hanrahan or Manzone in view of Pedone (U.S. Patent No. 3,913,513).

As to those rejections, independent claim 1 has been amended to recite that the claimed filter element also includes a second stage adjoining the first stage which second stage is formed of a second medium comprising a fill of a second oleophilic polymeric material. As original claims 14 and 15, now cancelled, reciting such features were rejected only under § 103(a) as being unpatentable over Hanrahan or Manzone in view of Pedone, the propriety of claim 1 will be addressed hereinafter in view of the rejections as to the original claims 14-21, 25 and 26.

The primary Hanrahan and Manzone references have been cited by the examiner as disclosing, evidently, an oil-sorbing filter element including a first stage formed of a first medium of a consolidated, permeable mass of a first oleophilic polymeric material. The secondary Pedone reference has been cited for the proposition that it is known to employ a plurality of filtration stages in an oil sorbent filter. The examiner is of the opinion that "it would have been obvious ... to employ a plurality of filtration layers in the system of either Hanrahan or Manzone, as suggested by Pedone, in order to provide enhanced oil removal capability for either of these primary reference filters."

However, it is well-settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1987), See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). The Federal Circuit has cautioned that the suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability. See *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

Applicants are mindful that evidence of a suggestion, teaching, or motivation to combine prior art references may be found not just in the references themselves, but also in the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, although "the suggestion more often comes from the teachings of the pertinent references." *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999), *citing Rouffet*, 149 F.3d at 1355. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the reason to combine must nevertheless be "clear and particular." *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000), *citing Dembiczak*, 175 F.3d at 999. "Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' " *Dembiczak*, 175 F.3d at 999, *quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

To the extent that considers the primary references to read on the claimed "consolidated, permeable mass of a first oleophilic polymeric material" of the first stage of the claimed filter element, it is not known why one of ordinary skill in the art would have looked to the secondary Pedone reference for the purpose of modifying the filters of the primary reference. In this regard, with reference to Fig. 2 of the reference, Pedone is directed to an arrangement wherein fluid is passed through alternate layers of large particle expanded resin (23) and small particle expanded resin (24). [col. 4, ll. 65-67]. Nowhere in the reference itself, nor in the primary reference, is there any teaching or other indication that the use of such particulate layers would be advantageous in combination with a layer of a consolidated mass as in a oil-sorbing filter element described in claim 1 as amended.

On this basis, Applicants submit that one of ordinary skill in the art, in attempting to modify either of the primary reference, would not have looked to Pedone as a solution to the problem framed by the Applicants. Of course, it might be assumed that it is always obvious to interchange materials that are known in the art. Such an assumption, however, would bespeak of the impermissible use of hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Accordingly, Applicants submit that even if the combination proposed by the examiner would have been sufficient to render the claimed invention obvious, there has yet to be articulated a suggestion or other motivation in the prior art or otherwise on which basis one of ordinary skill in the art would have been led to have combined the cited references in the manner proposed.

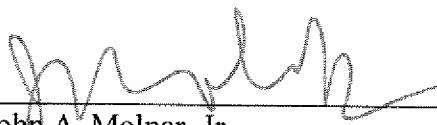
Moreover, and particularly as to claims 25 and 26 directed to arrangements wherein one of the stages radially surrounds the other stage, is believed that even if one of ordinary skill would have been properly motivated to combine the teaching of the cited references, such combination would not be sufficient to obviate the invention as claimed. That is, the secondary Pedone reference teaches, such as may be seen in Figs. 2 and 3, to arrange the layers in series. Accordingly, one following the teachings thereof would not have been led to the radial arrangement of stages as

described in claim 35 and 26, but rather would have arranged the layers in the series arrangement of Pedone.

On this basis, it is believed that claims 25 and 26 should be considered independently patentable. The remaining dependent claims 2-8, 10-13, 16-21, 23 and 24 further describe the filter element of claim 1, and should be considered patentable for the reasons given in connection therewith.

In view of the foregoing remarks, wherein the claim program as amended is believed to define the claimed invention as being patentable over art made of record, the issuance of a Notice of Allowance is earnestly solicited.

Respectfully submitted,



John A. Molnar, Jr.
Reg. No. 36,611
PARKER-HANNIFIN CORPORATION
6035 Parkland Boulevard
Cleveland, OH 44124-4141
Voice: (216) 896-2212
Fax: (216) 896-4027
E-mail: jmolnar@parker.com

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